

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed February 4, 2003. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has objected to certain informalities in the specification. In response thereto, pages 20, 25, and 34 of the specification have been amended.

The Examiner has rejected claims 6-20 under 35 U.S.C. 112, first paragraph, alleging certain informalities. In response thereto, independent claims 6, 11, and 16 have been amended.

The Examiner has rejected claims 1-4, 6-14, and 16-18 under 35 U.S.C. 102(e) as anticipated by U.S. Patent Application Publication 2002/0065772, published in the name of Saliba et al (hereinafter referred to as "Saliba"). This ground of rejection is respectfully traversed. Furthermore, enclosed herewith is the declaration of Charles A. Johnson, Esq. under 37 C.F.R. 1.131 which removes Saliba as a reference.

"It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact". *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986).

5 The rejection is respectfully traversed because Saliba does not meet every element of the claimed invention.

Claim 1, for example, is limited by a "user terminal which generates a service request and displays a report coupled to a publicly accessible digital communications network and having a
10 data base management system which generates said report".

Saliba does not contain this structure. The reference apparently has customers 28(1) and 28(2) coupled to Bank Web Sites 26(1) through 26(N). However, Bank Web Sites do not generate the bills (alleged by the Examiner to correspond to the claimed
15 report). Saliba indicates that it is fundamental to his invention that the preparation, generation, and storage of the bills is specifically not accomplished at the Bank Web Sites. The reference states at paragraph 0002 in part:

20 The bills, however, reside at an independent third party's location and not at the financial institution.

There is no showing that the customers have any interface with these "independent third party's location(s)". Therefore, Saliba cannot meet the remaining limitations of claim 1, as

well.

Similar issues arise with the rejection of the remaining claims. It should be clear that all pending claims are limited to a system wherein the data base management system generates some reports in response to service requests from the user terminal and generates other requests automatically without a service request. Both type of reports are generated by the same data base management system.

The Examiner has rejected claims 5, 15, 19, and 20 under 35 U.S.C. 103 as being unpatentable over Saliba in view of Admitted Prior Art. This ground of rejection is respectfully traversed for failing to show all of the claimed elements as explained above. In addition the Examiner not only does not provide evidence of reasonable likelihood of success as required by MPEP 2143, he does not even allege this result. Furthermore, the Examiner has failed to show motivation or reasonable likelihood of success of the alleged combination of Pollard and Geerlings as required by MPEP 2143. Specifically, the Examiner states:

It would have been obvious to one of ordinary skill at the time of the invention to incorporate the CLASSIC MAPPER database management system, since it is admitted as prior art that CLASSIC MAPPER is one of the most successful database management systems (see page 4, lines 9-12.

Furthermore, demonstrated commercial success implies that the product has features that are advantageous over competing products. (Else why would people buy it?)

5 Additionally, the desire to make one's system compatible with others would additionally provide motivation for one to choose a database management product that has a wide commercial success, since this necessarily means that many other systems also employ the same database management product, and thus compatibility with other systems is enhanced.

10 In other words, because Classic MAPPER exists and is successful, one would be motivated to combine Classic MAPPER with anything else. This finding is both incorrect as a matter of law and incorrect as a matter of logic. This is precisely the type of unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

15 Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

20 Therefore, the rejection of claims 5, 15, 19, and 20 is respectfully traversed for failure to show motivation as well.

25 In addition to these deficiencies, enclosed herewith is the declaration of Charles A. Johnson, Esq. under 37 C.F.R. 1.131 which effectively removes Saliba as a reference. This declaration is made by Mr. Johnson because of the unavailability of the sole inventor, who is a foreign national, ex-employee of the assignee of the present invention. In accordance with this declaration, the claimed invention was clearly conceived and fully reduced to practice before the effective date of Salibal, because the claimed

invention was on-sale and in public use before June 8, 1998.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, as amended, being the only pending
5 claims.

Respectfully submitted,

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By his attorney,

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Date

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